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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,061	02/06/2004	Marc Lewis	077615-0013	4826
31824 7590 03/02/2009 MCDERMOTT WILL & EMERY LLP 18191 VON KARMAN AVE. SUITE 500 IRVINE, CA 92612-7108				
EXAMINER				
STIBLEY, MICHAEL R				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,061

Applicant(s)

LEWIS ET AL.

Examiner

MICHAEL R. STIBLEY

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's remarks of 11/26/2008 are fully addressed in the present Office Action as featured below.

Applicant contends that the previous rejection based on §102(b) of the statute was improper. While Applicant is correct in §102(b) being an improper basis of rejection, §102(e) still applies. The rejections stand on the basis of §102(e). It was an inadvertent error to cite §102(b), when really §102(e) was the correct basis of rejection. Because the prior art reference cited, namely U.S. Patent Application Publication No. 2004/0024638 ("Restis"), remains the same, with the teachings of Restis and the citations remaining the same, finality is proper.

Therefore, Applicant's request for allowance and withdraw of the most previous Office Action have been carefully considered and respectfully denied in view of the current response. **Thus, the current Office Action is made FINAL.**

DETAILED ACTION

2. This Office Action is in response to the remarks filed on 11/26/2008. Please note change in Examiner.

Election/Restriction Requirement

3. Claims 1-37 are currently pending in the instant application. Claims 1-22 and 32-37 have been withdrawn from consideration as a result of a Restriction Requirement of 3/26/2008 in which Applicant elected Group III claims, namely claims 23-31, without traverse. Said Restriction Requirement is hereby made FINAL. Claims 23-31 have been examined.

Examiner Notes

4. Claims 23 and 29, which are directed to an apparatus, recite “wherein” clauses. These clauses do not distinguish the claims from the prior art. (See MPEP 2114; While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (*In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)))

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by William R. Restis (RESTIS)(US 2004/0024638 A1).**

Regarding claim 23, Restis discloses: A point of sale terminal comprising:

- a) a scanner means for reading product ids from products; ([0044]; [0059]; fig 4; [0070]-[0073])

- b) a machine-to-machine data input device for receiving a user id from a communication user agent; (fig 1, elm A104; fig 2B; fig 11; [0044]; [0069]; [0088]; clm 7)
- c) network communication means; and [0019]; [0023]; [0075]
- d) processing means operable to accumulate a total purchase price in dependence on product id codes read by the scanner means and store said code values, ([0085]; [0088]; fig 3, elm 501; [0090]; fig 4, elm 509; [0092])

wherein the processing means is configured to be responsive to a user id from said data input device to:

- i) transmit said user id to a remote location in a request message via the network communication means; [0071]; [0087]; [0090]; [0103]
- ii) receive a response to said request message via the network communication means, the response containing a list of product id codes; and (abstract; [0076])
- iii) reduce the accumulated purchase price in dependence on matches between elements in said list and said stored product codes. (abstract; [0033]; [0034]; [0084])

Regarding claim 24, Restis discloses: A point of sale terminal according to claim 23 (see claim 23 rejection), wherein the processing means is configured to be further responsive to a user id from the data input device to report said matches to a remote location via said network communication means. [0034]; [0035]; [0079]; [0080]

Regarding claim 25, Restis discloses: A point of sale terminal according to claim 23 (see claim 23 rejection), wherein the scanner means is a bar code scanner. ([0057]; fig 2B; [0069]; fig 11; [0088])

Regarding claim 26, Restis discloses: A point of sale terminal according to claim 25, wherein the machine-to-machine data input device comprises said bar code scanner. (fig 1, elm A104; fig 2B; fig 11; [0044]; [0069]; [0088]; clm 7)

Regarding claim 27, Restis discloses: A point of sale terminal according to claim 26 (see claim 26 rejection), wherein the processing means is configured to identify a user id by comparing a code from the bar code scanner with a range of codes not reserved for product ids. (fig 6B, elm 370; [0093])

Regarding claim 28, Restis discloses: A point of sale terminal according to claim 23 (see claim 23 rejection), including user input means, wherein the processing means is configured to identify a user id by detecting a predetermined operation of said user input means. (“... swipes ...” in [0069])

Regarding claim 29, Restis discloses: A transaction system comprising a point of sale terminal and a communication user agent, the point of sale terminal comprising:

- a) a bar code scanner means for reading product ids from products and a user id from a communication user agent, ([0044]; [0059]; fig 4; [0070]-[0073]; [0057]; fig 2B; [0069]; fig 11; [0088])
- b) network communication means, and [0019]; [0023]; [0075]
- c) processing means operable to accumulate a total purchase price in dependence on product id codes read by the scanner means and store said code values; ([0085]; [0088]; fig 3, elm 501; [0090]; fig 4, elm 509; [0092])

and the communication user agent being operable to display a bar code representing a user id code,

wherein the processing means of the point of sale terminal is configured to be responsive to a user id from said data input device to:

- i) transmit said user id to a remote location in a request message via the network communication means, [0071]; [0087]; [0090]; [0103]
- ii) receive a response to said request message via the network communication means, the response containing a list of product id codes, (abstract; [0076])
- iii) reduce the accumulated purchase price in dependence on matches between elements in said list and said stored product codes, and (abstract; [0033]; [0034]; [0084])
- iv) report said matches to a remote location via said network communication means. [0034]; [0035]; [0079]; [0080]

Regarding claim 30, Restis discloses: A system according to claim 29 (see claim 29 rejection), wherein the processing means is configured to identify a user id by comparing a code from the bar code scanner with a range of codes not reserved for product ids. (fig 6B, elm 370; [0093])

Regarding claim 31, Restis discloses: A system according to claim 30 (see claim 30 rejection), wherein point of sale means includes user input means and the processing means is configured to identify a user id by detecting a predetermined operation of said user input means. (“... swipes ...” in [0069])

Conclusion

7. THIS ACTION IS MADE FINAL See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/
Examiner, Art Unit 3688
Tuesday, February 24, 2009

/Jean Janvier/
Primary Examiner, Art Unit 3688